

REMARKS

Favorable reconsideration of this application in light of the preceding amendments and the following elections and remarks is requested.

No claims having been cancelled and claims 13-19 having been added, the Applicant submits that claims 1-19 remain pending and properly under consideration in the present application. The Applicant also submits that these amendments introduce no new matter. Specifically, the independent claims 1 and 7 and 10 have been amended to adopt the generic term “tissue-specific promoter” with new claim 14 now providing for selection between skin-specific and muscle-specific promoters. The Applicant contends that support for these amendments are found in at least paragraphs [00046-47] with regard to the range of tissue and structure promoters that can be incorporated in the plasmids and transgenic organisms according to the invention. Other amendments to the claims reflected above are intended to correct typographical errors, *e.g.*, claim 3, improve readability, and clarify antecedent bases. These amendments are supported at least by the claims as originally filed.

Restriction Requirement

The Examiner has imposed a Restriction Requirement, and requested that Applicant elect one of six identified groups of claims for prosecution in connection with the present application. The six groups of claims are as follows:

Group I (claims 1-4) directed to a recombinant plasmid where the second promoter is a skin-specific promoter;

Group II (claims 1-4) directed to a recombinant plasmid where the second promoter is a muscle-specific promoter;

Group III (claims 5-9) directed to a transgenic fish and methods for producing transgenic fish where the second promoter is a skin-specific promoter;

Group IV (claims 5-9) directed to a transgenic fish and methods for producing transgenic fish where the second promoter is a muscle-specific promoter;

Group V (claims 10-12) directed to methods for producing transgenic fish where the second fragment comprises a skin-specific promoter; and

Group VI (claims 10-12) directed to methods for producing transgenic fish where the second fragment comprises a muscle-specific promoter.

Applicant's Election

In response to the pending Restriction Requirement, the Applicant elects, with traverse, the claims of Group I (claims 1-4) as directed to a recombinant plasmid where the second promoter is a skin-specific promoter.

The Applicant further submits that in light of the amendments to the claims reflected above, the groupings of the claims for differentiating between the “skin-specific promoter” embodiments and the “muscle-specific promoter” embodiments are no longer applicable to claims 1-12 and that, consequently, these groupings should collapse into those claims directed to the plasmid, a transgenic fish having a genome that incorporates such a plasmid, and a method of producing a transgenic fish by incorporating such a plasmid.

The Applicant submits, therefore, that the generic plasmid construction recited in claim 1, and as further defined in dependent claims 2-4 and 14-17, defines the invention that should be examined in this application. With respect to those claims that incorporate a distinction between skin-specific and muscle-specific promoters, specifically claims 3 and 14, the Applicant elects the skin-specific promoters.

The Applicant contends that claim 1 is generic with respect to the various promoters and further contends that each of the other independent claims incorporates and utilizes the plasmid defined by claim 1. The Applicant submits, therefore, that in the event the plasmid defined by claim 1 is found allowable, each of the remaining claims that incorporate the recited plasmid construction should be rejoined, if previously withdrawn, and allowed.

The Applicant reserves the right to file one or more divisional applications for prosecution of the non-elected claims at any time during the pendency of this application.

CONCLUSION

An early indication of the allowability of claims 1-19 in connection with the present application is earnestly solicited.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, and particularly for extension of time fees.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, PLC

By: 
John A. Castellano, Reg. No. 35,094

P.O. Box 8910
Reston, VA 20195
(703) 668-8000

JAC/GPB:ame